

REMARKS

Claims 1-3, 5-8 and 29 are pending in the application. Claim 1 has been amended to more specifically recite the hair treatment agent. Support for this amendment can be found in the specification at page 11, lines 4-6.

Issues under 35 USC § 103(a)

Claims 1-3, 5-8 and 29 have been rejected under 35 USC § 103(a) as being unpatentable over Tetsuo et al. (EP 1065234 A2) in view of Nomura et al. (UK patent application 2138845 A). This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Response to comments in Advisory Action

In the Reply filed September 2, 2008, Applicants provided evidence, in the form of a Declaration submitted under 37 CFR 1.132, of the distinction between the methods of the present invention and those of Tetsuo et al. These results and distinctions can be summarized as follows.

The cosmetic of Tetsuo contains a powder which has been surface treated with organopolysiloxane. The process of surface-treating (or baking) the powder with the organopolysiloxane is the method by which the silicone is incorporated into the cosmetic. However, the treatment causes the organopolysiloxane to chemically bind itself to the powder surface, thereby altering the structure of the organopolysiloxane in the cosmetic. Therefore, although Tetsuo's silicone of formula (1) (as it exists prior to incorporation into the powder cosmetic) is similar to the organopolysiloxane of Applicants' formula (1), there is a significant and patentable distinction between the chemical structure of the two silicone components which exists after incorporation into the cosmetic. The organopolysiloxane of the instant invention remains unchanged in the cosmetic composition while the silicone of Tetsuo has an altered chemical structure as a result of the surface-treatment. This distinction between the organopolysiloxanes as they exist in the cosmetic compositions of the instant invention as compared to those of Tetsuo demonstrates the non-obviousness of Applicants' methods. But to

further demonstrate the unexpected and advantageous results discovered by Applicants, comparative data was submitted to substantiate this assertion.

In the Declaration submitted September 2, 2008, Applicants compared the silicone (9) of the invention (hair treatment agent (A)) to a titanium dioxide powder which was surface-treated with the same silicone (9) according to the process of Tetsuo (hair treatment agent (B)). Hair treatment agents (A) and (B) were applied to a hair bundle sample by shampooing, treating, rinsing and drying the samples. This was repeated 20 times. The samples were evaluated immediately after the 1st treatment with agent (A) or (B), and then further evaluated after the 20-cycle processing. These were compared to an untreated hair bundle sample. The results of the comparison, which can be found in Table 2 of the Declaration, showed that after the initial treatment and after the 20-cycle processing, the sample treated with hair treatment agent (A) of the invention showed results far superior to the sample treated with hair treatment agent (B) of the prior art. Applicants submit that hair treatment agent (B) was inferior due to the fact that the silicone (9) was chemically bonded to the powder contained in agent (B), thereby eliminating any hydrophilic reactive sites. In hair treatment agent (A), the silicone (9) exists unaltered and therefore is able to impart beneficial properties to the hair treatment agent.

In the Advisory Action, the Examiner states that “the limitations on which applicant relies (i.e. free organopolysiloxane) are not stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not.” The Affidavit was found unpersuasive for the same reasons. In response, Applicants point out that it is the nature of the cosmetic composition of Tetsuo that necessitated a showing of “free organopolysiloxane.” The crux of Applicants’ invention was not a discovery that the organopolysiloxane could exist in a “free” state. In other words, because the cosmetic of Tetsuo is in surface-treated powder form it was necessary to demonstrate how such a medium, when used in the methods of the invention, destroys the intended beneficial activity of the organopolysiloxane. Additionally, Applicants assert that they are not required to recite negative limitations in order to exclude everything that the claimed invention does not encompass.

Claim 1 has been amended to recite that the organopolysiloxane hair treatment agent is in the form of a dispersion or a solution in an organic solvent. By this amendment, Applicants' claims are further distinguished from the teachings of Tetsuo since the organopolysiloxane in a solution or dispersion cannot also be bonded to a powder as described in Tetsuo.

Applicants have argued that there was no motivation to combine the teachings of Tetsuo et al. with those of Nomura et al. in order to show that the organopolysiloxane hair treatment composition can be applied after a composition comprising an amino-modified silicone. In response, the Examiner states that Nomura teaches that "after a 30 minute application of combined first and second lotion the hair is sufficiently washed with a composition comprising SDS [sodium dodecylsulfate] and then water." The Examiner further states that Tetsuo teaches cosmetic compositions containing powders which have been surface treated with silicone and "may have surfactants such as SDS and used as hairdressing products such as shampoo, rinse and treatment. Therefore, one would have been motivated to use the shampoo composition of Tetsuo et al. for washing the hair after the hair dye treatment." It appears the Examiner is arguing that there is an equivalency between Nomura's 1 % sodium dodecylsulfate as a rinsing agent and Tetsuo's silicone composition which may contain SDS as a surfactant. However, a teaching that Tetsuo's organopolysiloxane surface-treated powder may contain SDS is not a teaching that it is equivalent to SDS. Nor would the skilled artisan expect these very different compositions to behave as equivalents.

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958)

Accordingly, since there is no teaching of equivalency between the surface-treated powder of Tetsuo and the 1 % sodium dodecylsulfate solution which Nomura uses in the second step of the hair dyeing process, the combination of Tetsuo et al. and Nomura et al. does not establish a *prima facie* case of obviousness.

Inasmuch as Tetsuo et al. fails to teach the instant method of conditioning hair by applying an organopolysiloxane hair treatment composition to the hair, and since the deficiencies of Tetsuo et al. are not overcome by the combination with Nomura et al., Applicants respectfully request that the rejection under 35 USC § 103(a) of claims 1-3, 5-8 and 29 over Tetsuo et al. in view of Nomura et al. be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy, Jr., Reg. No. 28,977 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: October 10, 2008

Respectfully submitted,

By 

Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant